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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,423	02/08/2002	Minutza Leibovici	1662/51303	1722

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EXAMINER	
LANDAU, SHARMILA GOLLAMUDI	
ART UNIT	**PAPER NUMBER**
1611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/071,423	LEIBOVICI ET AL.	
	Examiner	Art Unit	
	Sharmila Gollamudi Landau	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,9-15 and 50-78* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 9-15, 50-78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Amendments/Arguments received on 10/17/07 is acknowledged. Claims **2-6, 9-15, 50-78** are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 9-15, 50-78 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a stable pharmaceutical composition comprising torsemide modification II with no trace amounts of modification I (high purity torsemide modification II), wherein no more than 15% torsemide II does not rearrange into another form during storage for at least 3 months, does not reasonably provide enablement for applicant is not enabled for a stable pharmaceutical composition comprising torsemide modification II with trace amounts of modification I, wherein no more than 15% torsemide II does not rearrange into another form during storage for at least 3 months. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Enablement is considered in the view of the Wands factors (MPEP 2164.01 (a)). These include the nature of the claims, guidance of the specification, the existence of working examples, predictability of the prior art, and state of the prior art. All of the Wands factors have been considered with the regard to the instant claims, with the most relevant discussed below.

The instant claims are not enabled to prevent healing of the skin indefinitely and the process of treatment by prevention of healing.

Nature of the Invention: The rejected claims are drawn to a stable pharmaceutical formulation containing torsemide modification II wherein no more than 15% torsemide II does not rearrange into another form during storage for at least 3 months.

Breath of the claims: The breadth of the claim encompasses maintaining stability of torsemide modification II for at least 3 months using torsemide modification II with trace amount of torsemide modification I.

Guidance of the Specification: The guidance provided by the specification on page 5 discloses high purity torsemide modification II, with no trace amount of torsemide modification I, is stable during storage under stress conditions for at least 3 months. The specification also discloses: "In contrast, torsemide modification II that contains trace amounts of torsemide modification I is not stable during storage under stress condition for at least 3 months." The torsemide modification II containing trace amounts of torsemide modification I rearranges into torsemide modification I over time during storage under stress conditions.

The State of the Art: The state of the art recognizes the instability of torsemide modification II and that it rearranges into modification I within 10 to 14 days. See RE 34,672, column 2.

Working Examples: The examples in the specification demonstrate that high purity torsemide modification I is stable for stable for at least three months. However, Table 4 demonstrates that a composition with torsemide modification II with trace amount of modification I does undergo rearrangement in less than 3 months.

Response to Arguments

Applicant argues that page 11, lines 9-15 discloses that a composition comprising torsemide modification II containing trace amounts of torsemide modification I is stable. Applicant argues that Table 1 in page 9 of the specification also shows that the pharmaceutical composition comprising torsemide modification II containing trace amounts of torsemide modification I is stable. In addition, Table 4 in page 14 of the specification demonstrates that for torsemide modification II containing trace amounts of torsemide modification I was stable.

Applicant's arguments filed 10/17/07 have been fully considered but they are not persuasive. The examiner notes Table 1, however Table 1 merely shows the weight percent of each component in the composition and does not demonstrate the stability of the composition as argued by applicant. Further, the examiner notes page 11, lines 9-15, however this disclosure does not demonstrate the stability of the composition. The instant rejected claims are directed to a stable pharmaceutical formulation containing torsemide modification II wherein no more than 15% torsemide II does not rearrange into another form during storage for at least 3 months under stress conditions. As set forth in the rejection, page 5 of the specification discloses high purity torsemide modification II, with no trace amount of torsemide modification I, is stable during storage under stress conditions for at least 3 months. The specification also discloses: "In contrast, torsemide modification II that contains trace amounts of torsemide modification I is not stable during storage under stress condition for at least 3 months." The torsemide modification II containing trace amounts of torsemide modification I rearranges into torsemide modification I over time during storage under stress conditions. Applicant has not addressed this. Further, the examiner notes Table 4 wherein torsemide modification II with trace amounts of torsemide

modification I *after* two month contains both forms whereas at two months and less, Torsemide Modification II only rearranged to about 6%. The examiner notes dependent claim 10 is directed to the composition wherein not more than 5% of torsemide modification II rearranges into torsemide modification I. However, Table 4 of the instant specification discloses that torsemide modification II with trace amounts of torsemide modification I at two months rearranges to 6%. Applicant has not addressed this. Therefore, the rejection is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-6, 9-15, and 50-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,482,417. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Instant application claims a stable pharmaceutical composition high purity torsemide modification II that does not rearrange over time for at least three months. Further, the dependent claims recite particle sizes of 200, 100, and 50 microns.

US patent claims a pharmaceutical composition comprising torsemide modification that does not rearrange over time. The dependent claims recite a stable product that does not rearrange over time at least for three months. Further the dependent claims recite particles sizes of 200, 100, and 50 microns. The stable pharmaceutical formulation of claim 1, wherein said formulation further comprises lactose anhydrous, crospovidone, povidone, cellulose, and magnesium stearate.

Therefore, both instant application and US '417 are directed to similar subject matter.

Response to Arguments

Applicant states that a terminal disclaimer will be filed when the claims are found to be allowable.

The rejection is maintained until a Terminal Disclaimer if filed.

Claims 2-6, 9-15, 50, 52-78 are under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of 8-9 of U.S. Patent No. 6,465,496 in view of Topfmeier et al (RE 34, 672). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Instant application claims a high purity torsemide modification II. The dependent claims recite a stable product that does not rearrange over time for at least three months. Further, the dependent claims recite particle sizes of 200, 100, and 50 microns.

US '496 claims a pharmaceutical composition comprising torsemide Dupont Form 2 (torsemide modification II) and a pharmaceutically acceptable carrier and a method of treating edema.

US '496 does not claim the specific excipient.

However, Topfmeier et al teach a stable pharmaceutical composition comprising torsemide I with conventional excipients such as sugars, cellulose, and lubricating agents. Specifically, magnesium stearate is taught. See examples. RE 34, 672 teaches the instant particles ranges and the instant rate of dissolution on column 3, lines 10-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the instant excipients and arrive at the instant invention. One would have been motivated to do so with a reasonably expectation of success since Topfmeier et al teach the use of conventional additives such as the instantly claimed excipients for stable pharmaceutical compositions containing torsemide modification I and II respectively. With regard to the recitation of "high purity torsemide modification II" and "torsemide modification II containing trace amounts of modification I", the examiner points out that US '496 discloses the same process of making torsemide modification II as instant application and therefore, this property is considered inherent.

Response to Arguments

Applicant's arguments, see page 8-9, filed 10/17/07, with respect to the rejection(s) of claim(s) 2-6, 9-18, 52-74 over claims 81-82, 85-87 over US '496 under obviousness double patenting have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of claim(s) 2-6, 9-15, 50, 52-78 over claims 8-9 over US '496 which are directed to a pharmaceutical composition and a method of treating.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 2-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Dreckmann-Behrendt (5,914,336) as evidenced by US 6,166,045 (application 09/089066).

Dreckmann-Behrendt discloses a pharmaceutical composition comprising 10% of torsemide II and 45% of a mixture of torsemide modification I and III and excipients from example 8 of application 09/089,066, including magnesium stearate. See example 3 and 5. The reference discloses the use of excipients such as sugars, cellulose, and lubricating agents, known in the art, for an instant release oral tablet. Further, Dreckmann-Behrendt discloses the particle size of torsemide. (Note col. 3, lines 43-58). The reference discloses different doses (2.5 mg to 200 mg) according to dosage form and the use of torsemide as a diuretic and treatment of edema (col. 4, lines 35-60).

US 6,166,045, application 09/089,066, example 8 discloses torsemide combined with lactose, starch, colloidal silica, and magnesium stearate.

Conclusion

All the claims remain rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila Gollamudi Landau whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sharmila Gollamudi Landau
Primary Examiner
Art Unit 1616

SGL
1/2/08